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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/666,642	09/21/2000	Hu Yang	2039.008200	9201

23720 7590 05/14/2003

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EXAMINER

MULLIS, JEFFREY C

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/14/2003

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/666,642

Applicant(s)

YANG ET AL.

Examiner

Jeffrey C. Mullis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 16, 38-40, 42, 67-69, 81-83, 85, 99-101 and 114 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-4 6-30 32-73 75-91 93-115

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-91, 93-98, 102-113 and 115 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Bansleben et al. (6,255,248) in view of Cahill et al. (USP 6,083,585).

See the first Office action at the paragraph bridging pages 3 and 4 et seq.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-4, 6-11, 15, 17-30, 32-37, 41, 43-66, 70-73, 75-80, 84, 86-98, 102-113 and 115 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 7-23, 26-44, 46-51, 54-62 and 65-78 of U.S. Patent No. 09/595,410. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species of each application overlap and therefore choice of one specie over another would have been obvious in the expectation of adequate results.

Applicants' arguments filed 2-10-03 have been fully considered but they are not deemed to be persuasive.

Applicants' remarks regarding the status of the claims are correct except that applicants are incorrect regarding claim 31 which they allege has been withdrawn from consideration. Claim 31 has been cancelled as requested by applicants in their amendment of 6-13-02.

Applicants argue that the references do not disclose a blend of an oxygen scavenging polymer comprising a cyclic olefinic pendant group and an oxygen barrier polymer. While it is true that neither reference teaches such a blend, for the reasons set out above, it is the position of the Examiner that the combination of references suggests such a blend. Applicants argue that the references do not suggest the claimed invention because Bansleben failed to recognize the advantage of reduced

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oxygen permeability possible for films formed from blends of an oxygen scavenging polymer in a cyclic olefinic pendant group and an oxygen barrier polymer. However a proper rejection under 35 U.S.C. § 103 does not require that a reference be modified for the same reason that applicants may have modified it. Applicants' argument therefore has not pertinence with regard to the prima facie case of obviousness. Applicants' argument however that "one of ordinary skill in the art would have no basis to expect that films formed from blends of (i) an oxygen scavenging polymer comprising a cyclic olefinic pendant group and (ii) an oxygen barrier polymer would have reduced oxygen permeability relative to films formed from oxygen barrier polymers alone" does have pertinence with regard to the issue of unexpected results. However with regard to applicants' argument that "removing barrier polymer molecules, all other things being equal, would be expected to increase the permeability", it is immaterial what effect removing barrier polymer molecules would have since the primary reference requires an oxygen scavenging polymer. Unexpected results must be with the closest prior art which in the instant case would appear to be the primary reference and given that the primary reference requires an oxygen scavenging polymer, the effect of removing the oxygen barrier polymer is immaterial. The issue with regard to unexpected results is what one of ordinary skill in the art would expect

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when adding the specific oxygen barrier polymers of the primary reference such as BVDC to the oxygen scavenging compositions of the primary reference. However applicants have provided no data showing embodiments of the primary reference and those of the claimed invention in which the only difference between the embodiments of the primary reference is addition of oxygen barrier polymers. Comparative data showing the use of 100% EVOH as the comparative example is not probative of unexpected results since the primary reference does not teach a composition containing only a layer of EVOH, but rather requires a composition containing an oxygen scavenging polymer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Mullis whose telephone number is (703) 308-2820. The examiner can normally be reached on Monday-Friday from 9:30 to 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on (703) 308-2462. The fax phone number for this Group is before final (703) 872-9310 and after final (703) 8729311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

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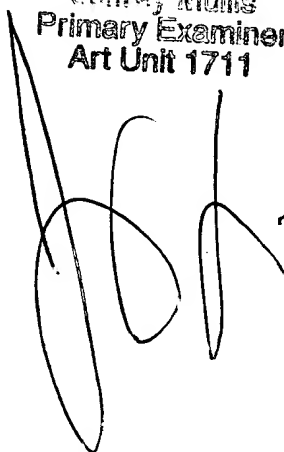
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J. Mullis:cdc

May 14, 2003

J. Mullis
Primary Examiner
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A handwritten signature in black ink, appearing to be 'JM', is written over the printed name and title of the Primary Examiner.